

REMARKS

The specification has been amended to include the accession number for the cosmid vector pPCos+ura.

Claims 22-24 have been canceled without prejudice. New claims 27-42 have been added to more particularly point out and distinctly claim that which Applicants regard as the invention. Applicants respectfully request the examination of the new claims which are directed to subject matter related to claims allowed and issued in the parent applications of the present application. The subject matter of the new claims is fully supported in the specification. In particular, support for new claims 27, 28 and 41-42 is found in page 62, lines 19-32. New claims 29-30 are supported in the specification at page 6, lines 28-34; page 25, line 23; page 53, line 18; page 63, lines 35-36; and page 64, lines 5-6. New claims 30-34 are supported at page 30, lines 5-9; page 29, line 12; page 29, line 21; page 49, line 14; and page 64, lines 5-6. New claims 35-36 are supported at page 29, lines 7-20; page 24, line 15; page 49, lines 10-21; page 64, lines 2 and 11; and page 52, line 25. New claims 37-40 are supported at page 25, line 33 to page 26, line 9. No new matter is added.

1. Priority Date Of The Claims

New claims 27-42 have been added to replace claims 22-24. The subject matter of the new claims relates to biased combinatorial gene expression libraries which are fully described and enabled in the parent application serial no. 08/738,944, and the grandparent application serial no. 08/639,255. Applicants respectfully submit that claims 27-42 are in compliance with the requirements of the first paragraph of 35 U.S.C. § 112 with respect to both these applications, i.e., serial nos. 08/738,944, and 08/639,255. Thus, under 35 U.S.C. § 120, the new claims are entitled to the benefit of the earliest priority date of the applications which is April 24, 1996 for application serial no. 08/639,255, .

2. The Rejection Under 35 U.S.C. § 103(a) Is Obviated

Claims 22-24 are rejected under 35 U.S.C. § 103(a) as being obvious over Stratagene catalog (1994) in view of Losson et al. (1983, Cell, 32:371-377) and Strasser et al. (U.S. patent 5,151,354 issued September 29, 1992). The Examiner alleged that the Stratagene catalog discloses the cosmid vector SuperCos1, Losson et al. discloses that

plasmids containing the appropriate origins of replication can function in both *E. coli* and *Schizosaccharomyces pombe*, and Strasser et al. discloses a yeast cosmid shuttle vector. The Examiner further alleges that it would have been obvious to modify the SuperCos1 cosmid vector in view of the teachings of Losson et al., and Strasser et al. Applicants respectfully disagree, and submit that there is no suggestion in any of the references to combine the teachings of the references to arrive at the cosmid vectors as claimed. One of ordinary skill in the art would not have the motivation to create a cosmid expression vector that could shuttle between *E. coli* and *S. pombe*.

Applicants submit that claims 22-24 are canceled without prejudice, and without conceding that the subject matter of claims 22-24 are obvious over the 1994 Stratagene catalog, in view of Losson et al. and Strasser et al. The new claims are directed to biased combinatorial gene expression libraries which are substantially related to the subject matters allowed and issued in the parent and grandparent applications. The references cited by the Examiner do not disclose or suggest biased combinatorial gene expression libraries as claimed. Thus, the new claims are unobvious, and the rejection under 35 U.S.C. § 103(a) is obviated. Applicants respectfully request withdrawal of the rejection.

CONCLUSION

Applicants respectfully request that the foregoing amendments and remarks be entered and made of record in the file history of the application. An early allowance is earnestly requested. If any issues remain in connection herewith, the Examiner is respectfully invited to telephone the undersigned to discuss the same.

Respectfully submitted,

Date October 15, 1998

Laura A. Coruzzi by: *Christina* ^{40,258}

Laura A. Coruzzi 30,742
(Reg. No.)

PENNIE & EDMONDS LLP
1155 Avenue of the Americas
New York, NY 10036-2711
(212) 790-9090

Enclosures